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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,326	12/05/2003	William J. Hartigan Jr.	HAR.US.3	1325

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EXAMINER
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CHAPMAN, GINGER T

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/707,326

Applicant(s)

HARTIGAN, WILLIAM J.

Examiner

Ginger T. Chapman

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/05/2003</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Drawings*

The drawings are objected to under 37 CFR 1.83(a) as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. The omitted structural cooperative relationships are:

**Figure 6:** apparatus (10) is secured to podiatric chair (48), securing member is not labeled or identified in Figure 6 nor described in the specification (page 10 [0028]).

Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Language Indicating Intended Use of the Apparatus***

Examiner notes in claims 9-11, 16, and 21-23 a recitation of the intended use of the claimed invention, i.e. the intended use as claimed is to enable the manipulation of the receptacle frame and support bar by an operator of the apparatus during a procedure such as a nail care, manicure or surgical procedure. The prior art applied is capable of manipulation by an operator during such procedures, i.e., the structure of the prior art is substantially the same as the structure claimed and is therefore capable of being manipulated by an operator during a procedure on a human patient's extremities.

The intended use of the apparatus must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

### ***Claim Objections***

**Claim 3** is objected to because of the following informalities: Claim 3 on lines 2-3 recites, "... conform to the least one of a patient's extremities." A literal reading renders the claim indefinite, as "the least one" is subjective and thus considered to be relative terminology.

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In light of independent claim 1 line 3 reciting “at least one of a patient’s extremities...”

Examiner therefore considers claim 3 as containing a typographical error and has interpreted the claim to read, “... conform to at least one of a patient’s extremities.” Appropriate correction is required.

**Claim 24** in line 4 recites the limitation “frame secured to a hand support bar of a manicure table”. It is unclear whether Applicant is positively reciting a hand support bar of a manicure table as part of the apparatus. If Applicant is claiming a hand support bar of a manicure table as part of the apparatus there is insufficient antecedent basis for this limitation in the claim. Examiner is therefore interpreting claim 24 as, “the frame adapted to be secured to a hand support bar of a manicure table.” Appropriate correction is required.

**Claim 25** in lines 4-5 recites the limitation “the frame removably secured to an item of furniture”. It is unclear whether Applicant is positively reciting an item of furniture as part of the apparatus. If Applicant is claiming an item of furniture as part of the apparatus there is insufficient antecedent basis for this limitation in the claim. Examiner is therefore interpreting claim 24 as, “the frame adapted to be removably secured to an item of furniture.” Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 4** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, claim 4 recites the broad group of fastening elements "...at least one taken from the group consisting of a hook, strap, tie, shock cord, hook and loop fastener, screw, and bolt," and the claim also recites "... and wherein said hook is..." which is the narrower statement of the range/limitation.

It is not improper under 35 USC 112, second paragraph, to present a dependent claim that presents a narrower range for an element than the range set forth in the claim from which it depends. Examiner suggests setting forth the narrower limitation for the hook element from the

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group of fastening mechanisms in a separate claim depending from the broad group recited in claim 4.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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Claims 1, 2, 4, 5, 6, 8, 9, 12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Lacore (US 2,519,771).

**Claim 1:** As seen in Figures 1 and 2, Lacore discloses an apparatus (C) for collecting debris generated from a procedure on a human's extremities comprising a support bar (F) adapted to support at least one of a patient's extremities (col. 1, line 50), and a frame (19) secured to a support bar, said frame adapted to receive at least one receptacle (18).

**Claim 2:** As seen in Figure 2, Lacore discloses the apparatus (C) further comprising at least one receptacle (18) disposed upon the frame (19).

**Claim 4:** As seen in Figures 1 and 2, Lacore discloses the apparatus (C) further comprising a fastening mechanism (15) for fastening the support bar to an item of furniture (C) wherein said fastening mechanism is at least one taken from the group consisting of a screw (15), and is adapted to removably secure at least one receptacle (col. 2, lines 40-43).

**Claim 5:** As seen in Figures 2, Lacore discloses the apparatus wherein said frame (19) is removably secured to the support bar (F) at two locations (20) (col. 2, lines 12-16), and is made of a flexible material adapted to hold its shape when flexed (col. 2, lines 19-20).

**Claim 6:** The apparatus of claim 5, wherein said flexible material is plastic or metal (col. 2, lines 19-20).

**Claim 8:** As seen in Figure 2, Lacore discloses the apparatus (C) wherein said receptacle (R) is made of at least one taken from the group consisting of plastic (col. 2, line 20).

**Claim 9:** As seen in Figure 2, Lacore discloses the apparatus wherein said receptacle is removable by at least one taken from the group consisting of pulling to overcome a friction fit (col. 3, lines 8-12).



**Claim 12:** As seen in Figure 1, Lacore discloses the apparatus further comprising an item of furniture, said item of furniture being one selected from the group consisting of a podiatry chair (C).

**Claim 14:** As seen in Figure 2, Lacore discloses the apparatus wherein said frame (19) is substantially rigid (col. 2, lines 19-20).

Claims 3, 7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lacore (US 2,519,771) in view of Hartigan, Jr. (US 5,396,904).

**Claim 3:** Lacore does not disclose the apparatus wherein said support bar (F) has at least one recess adapted to conform to the least one of a patient's extremities. As seen in Figure 1, Hartigan teaches an apparatus (10) for collecting debris generated from a procedure on a human's extremities wherein the support bar (col. 2, lines 67-68) has at least one recess adapted to conform to at least one of a patient's extremities (col. 3, lines 8-10). Hartigan teaches that the benefit of this design is that the recess allows the debris removed from the patient's extremity to be contained within the bottom of the receptacle attached to the support bar. Therefore, to form the support bar of Lacore having a recess adapted to conform to at least one of a patient's extremities would have been obvious to one having ordinary skill in the art at the time the invention was made, since Hartigan teaches at column 2, lines 61-64 that such a modification allows an enveloping receptacle that encloses the portion of the patient on which the procedure is to be performed and at column 3, lines 16-17 that the debris removed from the patient is thus contained within the receptacle for disposal.

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**Claim 7:** Lacore does not disclose a sleeve. As seen in Figure 2, Hartigan teaches the apparatus (10) wherein the frame is covered by a sleeve (38, 52). Sleeves are well known as bushings in the mechanical art used to limit the size of openings, resist abrasion or serve as a guide. In view of this known teaching, to utilize a sleeve as taught by Hartigan in the apparatus of Lacore in order to provide a guide member for the frame would have been obvious to one having ordinary skill in the art at the time the invention was made in order to hold the frame members in a desired fix position with respect to one another.

**Claim 13:** Lacore does not disclose the apparatus further comprising a transparent examination shield secured to an adjustable arm secured to the support frame. As seen in Figures 6 and 8, Hartigan discloses a transparent examination shield (14) secured to an adjustable arm (81, 83) secured to the support frame (77). Hartigan states at column 2, lines that the benefit of this design it that the shield allows the receptacle to enclose the portion of the patient on which the procedure is performed in order to provide containment of the debris generated from the procedure while allowing the angle of the viewer to be varied with respect to the frame (col. 5, lines 42-44) in order to enhance viewing of the patient by the operator of the apparatus. Therefore, to form the receptacle of Lacore having a transparent shield secured to an adjustable frame as taught by Hartigan would have been obvious to one having ordinary skill in the art at the time the invention was made since Hartigan states that such a modification allows the operator enhanced viewing of the patient during the procedure.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lacore (US 2,519,771) in view of Weickgenannt (4,936,836).

**Claims 10 and 11:** Lacore does not disclose the frame is adapted so that the area enclosed by the frame and the bar when in communication with each other can be altered by an operator; and such that the width of the frame can be changed by an operator without changing the area. As seen in Figures 6A-6C, Weickgenannt teaches the area enclosed by the frame (15) and the bar (22) when in communication with each other can be altered by an operator (col. 6, lines 15-43). Weickgenannt states at column 3, lines 26-29 that the benefit of this design is that it maximizes the number of positions in which the operator has steady elbow support while conducting the procedure. In view of the teachings of Weickgenannt it would have been obvious to one having ordinary skill in the art at the time the invention was made to adapt the frame so that the area enclosed can be altered by an operator and that the width of the frame can be changed without altering the area, since Weickgenannt states at column 4, lines 12-16 that such a modification allows the operator maximum maneuverability toward or away from the patient during the procedure.

Claims 15-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piraneo et al (US 5,979,841).

**Claim 15:** As seen in Figures 3, 4 and 11-16, Piraneo et al disclose an apparatus comprising a receptacle cartridge (120), the cartridge comprising a frame (122) and a plurality (fig. 3: 66) of receptacles (68) removably secured to the frame (col. 9, lines 1-3). Piraneo et al teach the receptacle cartridge (66) as capable of being mounted to a support surface (col. 9, lines 1-5). Piraneo, at column 2, lines 10-18 expresses the desire for a receptacle dispensing system capable of suspending and dispensing receptacles wherein the support frame is does not obstruct

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the movement of the person using the receptacles. Therefore to form the receptacle cartridge as taught by Piraneo et al in order to provide a frame having a plurality of receptacles capable of being dispensed without obstructing the user of the receptacles would have been obvious to one having ordinary skill in the art at the time the invention was made.

**Claim 16:** Piraneo et al disclose the apparatus wherein the cartridge further comprises a fastening mechanism (133) adapted to fasten the cartridge to a support bar (col. 9, lines 3-5).

**Claim 17:** Piraneo et al disclose the apparatus wherein the fastening mechanism is the least one taken from the group consisting of screws (133: col. 9, lines 5-6, see also col. 5, lines 44-45).

**Claim 18:** Piraneo et al disclose the apparatus wherein said frame is made of plastic or metal, and is adapted to hold its shape when flexed (col. 9, lines 27-28).

**Claim 19:** Piraneo et al disclose the apparatus (fig. 11) wherein the frame is covered by a sleeve (122).

**Claim 20:** Piraneo et al disclose the apparatus wherein the receptacle (164) is made of at least one taken from the group consisting of plastic (col. 7, lines 41-44).

**Claim 21:** Piraneo et al disclose the apparatus wherein the receptacle is removable by at least one taken from the group consisting of disassembling a glued connection (col. 9, line 6).

**Claim 22:** Piraneo et al disclose the apparatus wherein the frame is adapted such that the area enclosed by the frame and the bar when in communication with each other can be altered by an operator (col. 4, lines 11-12).

**Claim 23:** Piraneo et al disclose the apparatus wherein the frame is adapted so that the width of the frame can be changed by an operator without changing the area (col. 10, lines 39-42).

Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuphal (US 4,221,371).

**Claim 24:** Kuphal, at column 1, lines 27-28 expresses the need for an procedure table having a patient support and a collection receptacle whereby freedom of movement of the operator is not obstructed. As seen in Figure 1, Kuphal discloses an apparatus (fig. 1) for collecting debris from a procedure on a patient comprising an adjustable, flexible frame (15) adapted to receive a flexible, disposable receptacle (28), the frame secured to a hand support bar (1) of a table (2). Kuphal teaches that the benefit of this design is that the flexible frame and collection receptacle do not obstruct the movement of the operator of the apparatus during the procedure (col. 1, lines 45-50). It would therefore have been obvious to one having ordinary skill in the art at the time the invention was made to form the flexible frame secured to the patient support of the procedure table as taught by Kuphal since Kuphal state at column 5, lines 29-33 that such a modification provides the operator with a flexible frame and receptacle that do not obstruct the operator during their work on the patient.

**Claim 25:** Kuphal discloses an apparatus for collecting debris generated from a procedure on a human's extremities comprising a flexible, adjustable frame (15) adapted to receive a flexible, disposable receptacle (28), the frame removably secured (col. 4, lines 18-23) to an item of furniture (2). Kuphal teaches that the benefit of this design is that the flexible

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frame and collection receptacle do not obstruct the movement of the operator of the apparatus during the procedure (col. 1, lines 45-50. In view of the teachings of Kuphal it would therefore have been obvious to one having ordinary skill in the art at the time the invention was made to form the flexible frame removably secured to an item of furniture (2) as taught by Kuphal since Kuphal state at column 5, lines 29-33 that such a modification provides the operator with a flexible frame and receptacle that do not obstruct the operator during their work.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginger T. Chapman whose telephone number is (571) 272-4934. The examiner can normally be reached on Monday through Friday 8:30 a.m. to 5:00 p.m..


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (571) 272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ginger Chapman  
Examiner, Art Unit 3761

~~6/20/05~~ 6/13/05

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Larry I. Schwartz  
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